



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takashi IGARASHI et al.

Group Art Unit: 3723

Application No.: 10/611,918

Examiner: H. SHAKERI

Filed: July 3, 2003

Docket No.: 108833.01

For: LENS MACHINING APPARATUS, LENS MACHINING METHOD, AND LENS MEASUREMENT METHOD

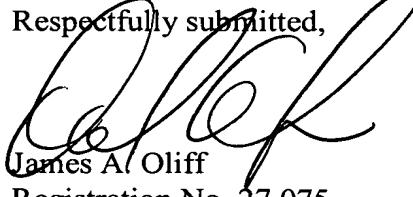
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Extension of Time. Review of the April 22, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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REMARKS

Claim 5 is pending in this application. On August 18, 2008, Applicants filed a Request for Reconsideration After Final Rejection ("Request") that argued over the objections and rejections made in the previous Office Action. An Advisory Action was mailed on August 26, 2008, indicating Applicants' arguments have been considered but do not place the application in condition for allowance. The Advisory Action states the arguments regarding the §112, second paragraph, rejections are moot. This does not address Applicants' arguments regarding the objection to the drawings. The Advisory Action also states that "with regards to the obviousness rejections, as was indicated in the previous Office Action, modifying JP '346 in view of types of operations, e.g. chamfering ... and for the table to disclose the thickness is considered by the Examiner to be within the knowledge of one of ordinary skill in the art." This rebuttal does not give full weight to the scope of arguments presented in the Request. Nor are the conclusions of the Office Action, as repeated in the Advisory Action, reasonable or supportable based on the currently-applied references.

The previous Office Action, mailed September 17, 2007, rejected claim 5 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The Office Action asserted that recited features were not shown in the Table in Fig. 4. In response to Applicants' arguments, the rejection of claim 5 under 35 U.S.C. §112, second paragraph, was withdrawn. This Office Action objects to the drawing alleging that the Table in Fig. 24 does not specifically show a turning speed of the revolving machining tool, the turning speed of the held lens, and a number of revolutions of the lens. In the exemplary embodiment shown in Fig. 24, it is not necessary to delineate each of the recited parameters. These features are not amenable to questionable construction. Where the detailed illustration of a specific feature is not essential to the proper understanding of the invention, exemplary embodiments, such as

those shown in the Figures of this application, suffice to clearly represent the recited terms.

Withdrawal of the objection to the drawing is respectfully requested.

As noted above, the Advisory Action incorrectly discusses the previously-withdrawn §112, second paragraph, rejection of the pending claim, but fails to address the arguments above from Applicants' August 18 Request, traversing the objection.

The Office Action, in paragraph 3, rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over JP-A-64-016346 (hereinafter "JP '346"). The Office Action, in paragraph 4, rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over JP '346 in view of U.S. Patent No. 5,053,971 to Woods. These rejections are respectfully traversed.

JP '346 teaches a technique for rough-machining and finish-machining workpiece, in which a technique is described for subjecting the workpiece to milling by a milling-cutter under NC control which is characterized by precision (see, e.g., page 1 of JP '346).

Woods teaches types of desired bevels to be formed on a lens circumferential surface being determined, and the placement of such bevels being accurately set by mapping both front and rear surfaces of a lens blank, and by verifying that there will be sufficient thickness at the peripheral edge of the cut lens to permit beveling and to ensure that chipping or fracturing of the lens edge will not occur when the optical lens is being edged (see, e.g., col. 4, lines 17-45, col. 8, lines 11-19, and col. 9, line 57 and below).

JP '346 discloses only that a material to be machined is roughly machined and finishing-machined. Specifically, the materials on which JP '346 operates are manufactured by milling-cutter controlled by NC device. JP '346 does not teach that any circumference can be machined under almost the same conditions and that machine surfaces can be finished to have uniform conditions in any conditions of roughly machining and performing finishing machining for edging the circumferential surface as recited in the pending claim.

In JP '346, milling is described which generally stated is a method of fixing a workpiece and moving a blade with respect to the fixed workpiece, as conventional milling is understood by those of ordinary skill in the art. Conversely, the edging method of the pending claim is one in which the workpiece is subjected to edging by rotating a tool while rotating a lens. Attempting to edge a circular spectacle lens with a milling-cutter as disclosed in JP '346 would likely result in breaking the spectacle lens or developing cracks in the edged surface. Milling by a milling-cutter controlled by an NC device, as disclosed in JP '346 is generally directed at machining a curved surface. In this regard, JP '346 may be used to machine the curved surface of a spectacle lens, but would not be amenable to being adapted to edging a plastic spectacle lens. For at least these reasons, it is not reasonable to conclude that, given the teachings of JP '346, one would have predictably modified those teachings in the manner suggested by the Office Action with any reasonable expectation of success to render obvious the subject matter of the pending claim.

The Office Action concedes that JP '346 does not explicitly disclose groove engraving and chamfering, as positively recited in the pending claims. The Office Action concludes, however, that such modification would have been obvious by adapting a method and the table to output values for grooving and chamfering. Otherwise, the Office Action indicates that Woods allegedly makes up for the shortfalls in the application of JP '346 to the subject matter of the pending claim. Both of these conclusions, and the limited analysis underlying these conclusions, fail for at least the following reasons.

Woods does not teach an entire circumference can be machined under almost any conditions and a machined surface can be finished to uniform conditions in any conditions by roughly machining and performing finishing machining for edging the circumferential surface of the lens being machined with all of the features positively recited, for example, in claim 5. Woods teaches edging to include beveling, grooving and chamfering. Woods, however, does

not teach rough machining and finish machining. The "edging" of the subject matter of the pending claim is, therefore, different from the allegedly corresponding edging of Woods. An object of Woods is to determine accurately the placement of the bevel regardless of the size, base curve and the shape of a lens (see, e.g., col. 9, lines 54 and 55). Conversely, the pending claim is directed to machining an entire circumference under almost same conditions, finishing machine surfaces to uniform conditions in any conditions, i.e., any type of lens being machined, and decreasing lens axis displacement and increasing tool life (see, e.g., page 66 of Applicants' disclosure). The Office Action indicates that Woods allegedly teaches chamfering or beveling lenses in which proper speed and feed rate are set based on the material selected and thickness. Woods, however, does not specifically disclose a method for adjusting the speed (and the number of revolutions) for obtaining maximum efficiency of the lens manufacturing method disclosed. Additionally, in Woods, the material selected relates to the type of bevel (see, e.g., col. 9, lines 57 and below). Finally, the thickness discussed in Woods relates only to verifying that there will be sufficient thickness at the peripheral edge of the cut lens to permit beveling and at attempting to ensure that chipping or fracturing of the lens edge will not occur when the optical lens is being edged (see, e.g., col. 4, lines 17-45).

By contrast to the above, the pending claim is directed to a method by which a thickness of a lens is input and the lens is machined at a rate corresponding to the thickness of the lens (see, e.g., page 64, line 19 - page 65, line 26). It is for these reasons that Woods does not make up for any shortfall in the application of JP '346.

Further, it is unreasonable to conclude that one of ordinary skill in the art would have predictably modified JP '346 on its face, as is asserted, in conclusory manner, in paragraph 3 of the Office Action, or predictably combined JP '346 with Woods in the manner suggested by the Office Action, as is asserted in conclusory manner in paragraph 4, with any reasonable expectation of success. With regard to this latter conclusion, JP '346 relates to machining

curved surfaces, namely machining surfaces. As discussed above, JP '346 cannot be adapted to circumferential surface machining of a lens to be machined. As such, JP '346 does not give any suggestion of the type of plastic lens and the thickness of the lens to be rough machined and finish machined, as may be suggested by Woods. It is not reasonable, therefore, to conclude that one of ordinary skill in the art, even given the disclosures of JP '346 and Woods, would have predictably combined and/or modified the disclosed inventions in the manner suggested by the Office Action with any reasonable expectation of success, and no other objective evidence of record has been provided to support these mere conclusions. Attempting to modify JP '346 in the manner suggested would require such restructuring of the disclosed device to make the asserted modifications impermissible.

To any extent that Woods teaches edging, it is not a reasonable conclusion, simply based on this assertion, that one of ordinary skill in the art would have predictably combined any of the teachings of Woods with JP '346 as is suggested by the Office Action, in achieving the objectives which are intended to be achieved by, and in the manner of, the subject matter of the pending claims. Even post-*KSR*, the analysis supporting an obviousness rejection must be explicit in that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." This standard is not met here with the mere conclusory statement that one of ordinary skill in the art may have (1) modified JP '346 in the manner suggested, or (2) combined any disclosure of edge beveling and/or chamfering of Woods with the machining process of JP '346 "to adapt the method for operations like chamfering, grooving, etc." In other words, to any extent that this conclusion provides what can even be asserted as an articulated reasoning, there is no rational underpinning for this alleged articulated reasoning.